

REMARKS

Claims 1-3, 5-8, 11, 24, 31 and 35 have been amended. Claims 39 and 40 have been added. Therefore claims 1-40 are now pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 102(e) Rejection:

The Examiner rejected claims 1-15, 22-31 and 33-36 under 35 U.S.C. § 102(e) as being anticipated by Chirashnya (U.S. Publication 2002/0019870). Applicant respectfully traverses this rejection and request reconsideration in view of the following remarks.

Claim 1 of the present application recites, in part, a host computer system configured to **“perform system discovery to generate data indicative of the configuration of the plurality of network components”** of a network system, and, **“in response to identifying a failed component, to update an availability of the network system using the data indicative of the configuration”**.

Chirashnya teaches constructing “a causal network” “responsive to an alarm indicative of a fault” (Abstract). The causal network “is constructed associating the fault with malfunctions in one or more of the modules that may have led to the fault and relating a conditional probability of the fault to respective probabilities of the malfunctions. Based on the alarm and the causal network, **at least one of the probabilities of the malfunctions** is updated. A diagnosis of the alarm is proposed responsive to the updated probabilities” (Abstract). “When **the estimated malfunction rate of a given module exceeds a certain threshold**, the diagnostic system declares the module to be fault-suspect, and issues a recommendation to a user of the system **to test or replace the suspect module**” (Paragraph 0010, see also paragraph 0059).

In rejecting claim 1, the Examiner asserts that Chirashnya teaches “calculating the availability of the plurality of network components using the data indicative of the configuration of the plurality of network components”, and cites paragraph 0005 of Chirashnya in support of this assertion. The Examiner’s interpretation of Chirashnya is incorrect. Paragraph 0005 discusses “model-based diagnostic approaches” used to “analyze a functional model of the system in question to **identify faulty components in the case of malfunction**”. “As long as the system model is updated to reflect configuration changes, these algorithms will automatically adapt the diagnostics to the changes that are made”. Paragraph 0005 of Chirashnya makes absolutely no mention of updating the availability of the network system using configuration data gathered from a system discovery process. In paragraph 0052, Chirashnya teaches “a diagnostic engine” configured to “update reliability assessments for the modules associated with each alarm”, but does not teach or suggest “**updating an availability of the network system**”, as recited in amended claim 1. Applicant can find no teaching or suggestion in either Chirashnya of **updating an availability of the network system**, much less **updating an availability of the network system using configuration data gathered in a system discovery process**, as recited in amended claim 1. Accordingly, the rejection of claim 1 is unsupported by the cited art.

Independent claims 7, 23, 34, and 35 each also recite computing or calculating an availability of a network system using configuration data obtained via system discovery, and therefore the rejection of these claims is unsupported by the cited art for similar reasons as claim 1.

Claim 2 recites, in part, using “the updated availability to calculate **a risk of the network system becoming unavailable during one or more exposure periods following the failure and prior to a repair or replacement of the failed component**”. Applicant can find no teaching or suggestion of such a risk calculation in Chirashnya. The section of Chirashnya cited by the Examiner does not teach this limitation.

Claim 5 recites a host computer system configured to “compare the risk of the network system becoming unavailable for a first exposure period of the one or more exposure periods to a threshold value, and, if the risk is higher than the threshold value, **determine an acceptable exposure period, wherein the risk of the network system becoming unavailable during the acceptable exposure period is lower than the threshold value, and provide an indication of the acceptable exposure period**”. The section of Chirashnya cited by the Examiner does not teach this limitation..

Section 103(a) Rejections:

The Examiner rejected claims 16-19, 32, 37 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Chirashnya. The Examiner states that the features of claims 16-19 and 32 “constitute a design choice rather than a patentable distinction.” **The Examiner has not stated proper grounds for rejection.** All inventions constitute design choices made by the inventors. The statute clearly places a burden of proof on the Patent Office which requires the Examiner to produce a factual basis for his rejection of an application under sections 102 and 103. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). The Examiner’s statement that these claim features are a matter of design choice is a conclusory statement with no factual basis. The Examiner has not provided any prior art reference establishing the obviousness of the recited claim limitations in combination with the other limitations of Applicant’s claimed invention. As the Court of Appeals for the Federal Circuit recently explained in *In re Sang Su Lee*, Docket No. 00-1158 (Fed. Cir. January 18, 2002), conclusory statements such as those provided by the Examiner that a claim limitation is only a design choice do not fulfill the Examiner’s obligation. “Deficiencies of the cited references cannot be remedied by the [Examiner’s] general conclusions about what is ‘basic knowledge’ or ‘common sense.’” *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). “Common knowledge and common sense ... do not substitute for authority.” *In re San Su Lee*. Common knowledge “does not in and of itself make it so” absent evidence of such knowledge. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999). The Examiner’s rejection of claims 37 and 38 is also

completely lacking any evidentiary support. Thus, the Examiner has failed to state a *prima facie* rejection of claims 16-19, 32, 37 and 38.

The Examiner rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Chirashnya in view of Rogers (U.S. Publication 2003/0048782). Applicants traverse this rejection at least on the grounds that the Examiner has not shown Rogers to be a prior art reference. More specifically, Rogers is a published U.S. patent application that was filed on Nov. 1, 2002, after Applicants' filing date of Mar. 6, 2002. Rogers does claim the benefit of a provisional application filed Nov. 1, 2001 and is a continuation-in-part of application No. 09/746,744, filed Dec. 22, 2000. However, the filing date of these priority applications can only be used as Rogers' prior art date for the subject matter that is common to both the published application and the respective priority application. Since it is common practice for a later filed utility application to include more or different subject matter than its earlier provisional application, it is unclear whether the material in Rogers relied upon by the Examiner was actually present in Rogers' provisional application. Likewise, since Rogers' is a CIP, by definition Rogers' published application includes material that was not present in its parent utility application. Therefore, Applicant asserts that the Examiner must show that the subject matter on which the Examiner is relying on to reject Applicant's claims is also present in Rogers' provisional application or Rogers' parent utility application. Until the Examiner has made this showing, the rejection is improper. *See, In re Wertheim*, 209 USPQ 554 (CCPA 1981).

Moreover, Rogers' published application is not entitled to the filing date of one of its priority applications unless at least one claim of Rogers' published application is supported (under 35 U.S.C. § 112) in a respective one of the priority applications that also includes the subject matter relied upon for the rejection. Under 35 U.S.C. 119(e)(1) & 120, a published utility application is not entitled to its priority application's filing date as a prior art date unless at least one claim of the published utility application is supported (per 35 U.S.C. § 112) in the priority application. The rejection is improper unless the Examiner can show that Rogers' published application has the necessary claim

support in a respective one of the priority applications that also includes the subject matter relied upon for the rejection. *See also* M.P.E.P. § 2136.03(IV).

The Examiner has the burden of proof to produce the factual basis for the rejection. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968). **Since the Examiner has not proven that both of the above requirements have been met for Rogers' teachings to qualify as prior art, the Examiner has not met this burden of proof and the rejection is improper.**

Applicant also asserts that numerous ones of the other dependent claims recite further distinctions over the cited art. However, since the rejection of the independent claims has been shown to be unsupported by the cited art, a further discussion of the dependent claims is not necessary at this time.

CONCLUSION

Applicant submits the application is in condition for allowance, and notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10100/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☒ Other: Information Disclosure Statement and Form PTO-1449

Respectfully submitted,



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